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10/043,545	01/10/2002	Altat Mulla	482XB	9646

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EXAMINER

LEE, DIANE I

ART UNIT PAPER NUMBER

2876

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/043,545

Applicant(s)

MULLA ET AL.

Examiner

D. I. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 13 January 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed 13 January 2003.
2. Acknowledgement is made that this application is a division of U.S. Patent Application Serial No. 09/227,245, filed January 8, 1999, now abandoned. Acknowledgement is also made of an updates in the Reference to Related application for a reason that the currently claimed invention (i.e., *one of the components being movable between a first position and a second position relative to the window*) has not been "wholly" disclosed until application Serial No. 09/227,245). Therefore, the effective filing date for the currently claimed invention is 08 January 1999.

Additional Remarks

3. Upon reviewing the application, the examiner has discovered the discrepancy in the previous Action. In the previous Office Action, the examiner acted on claims 1-9, which were canceled by the applicant in the Preliminary Amendment. In order to correct the discrepancy in the previous action, the examiner hereby set forth new Office Action. Therefore, this action **is not** made FINAL. The examiner regrets any inconvenience to the applicant.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly

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owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 10-22 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang [US 5,617,304] in view of Plesko [US 5,506,394], Barkan [US 6,098,877-referred as Barkan], and Kobayashi et al. [US 4,129,369-referred as Kobayashi].

Re claims 10-18, 21-22, and 27-29: Huang discloses a portable optical instrument having a combination of ballpoint pen 10 as a marker facing the surface to be marked during the marking mode (i.e., writing mode) and laser pointing unit 20 for creating a visual display on a target during a pointing/aiming mode of operation (see col. 1, lines 59+ and figures 1 and 4), the instrument comprising:

the portable, hand-held housing having a size and a shape configured to be held in a user's hand during both marking and aiming or pointing mode. The housing is elongated and extends along an axis between opposite end regions, and wherein the marker is located at one of the end regions and the pointer is located at other end regions (see figure 4). The housing having marker located at one end of the regions of housing (i.e., a ball point pen as a writing instrument supported by the housing) and the pointer at other end of the regions (see the abstract, col. 2, lines 39+ and figure 4) (see col. 1, lines 16-23 and 59-63; col. 2, figures 1, 4). The housing bounds an interior in which the internal component 22 is accommodated. The housing as separable portions 10, 20, which upon separation, enabling an access to the interior and an exterior clip 25 for clipping the housing to a part of the user's clothing (see col. 1, line 59-col. 2, line 43 and figure 1).

a laser emitter 224 supported by the housing 20 for emitting a laser light beam along a path outwardly of the housing towards the target and producing a beam pattern (e.g., a spot scan pattern) on

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the target when in a pointing mode in which a visual display is created on the target (see col. 1, lines 29-38; col. 2, lines 1-42; and figures 1-4).

Huang does not disclose the apparatus having plurality of optical components to electro-optically read coded indicia as set forth in the claims.

Plesko discloses a stylus beam scanning device for utilizing as a bar code scanning device (see the abstract). The indicia reader/scanner housing having a size and shape configured to be held in a user's hand during reading mode (see figure 1). Plesko shows the scanner having a plurality of electrical and optical components supported by the housing, including a laser light source for generating and directing the light beam as a visible laser beam along an optical path, a light sensor having a field of view for generating an electrical signal indicative of the detected light, a manually actuatable trigger 2, and etc. (see figures 1-5). When scanning the indicia, the light transmissive element of the housing faces the indicia and the light directed by the laser light source passes in one direction through the element and the reflected light passes in an opposite direction through the element to be detected by the light sensor having a field of view (see figures 7-8), and for generating an electrical signal indicative of the detected light (see col. 17, lines 9+). The front end 16A of the scanner where the light enters and exits as indicated by 6, 7 in figure 7 serves as a window, and the window is oriented generally perpendicular to a longitudinal axis of the reader. The reader comprising a detector 14 for detecting the light reflected off the coded indicia and generating an electrical signal indicative of the detected light intensity (see col. 17, lines 9+). Plesko further discloses the reader having a processor 35 for decoding the electrical signal into data represented by the coded indicia, a memory for storing the data within the housing (see col. 16, lines 9-16; col. 18, lines 1-8), a scanning module 100 as a drive supported by the housing for scanning the emitted laser light beam across the target (see col. 16, lines 27+ and figure 8), and a manually actuatable switch 2 for activating the detector to enable the unit to activate the scan sequence (see col. 15, lines 61+). Plesko further discloses that the stylus beam scanning device can be utilized as a laser pointer (see col. 18,

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lines 14). The scan module drive for moving the laser light beam along a path outwardly of the housing towards the target and producing a beam pattern (e.g., a spot, a line, or an elliptical scan pattern) on the target when in a pointing mode in which a visual display is created on the target (see col. 18, lines 14+).

In view of Plesko's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the scanning system in the pointer unit of Huang in order to provide a dual optical device that utilize as an aiming device which target can be pointed or highlighted and as a reader capable of reading bar code. Accordingly, such modification would provide greater capability and more feasible system. Therefore, it would have been an obvious expedient.

Huang as modified by Plesko fails to teach the instrument having one of the electrical and optical component movable between a two position (i.e., a first position for a first foci in pointing and a second position for a second foci in reading) and an actuatable switch operatively connected to move the component between positions to selectively focus the light beam at the first and second foci in the pointing and reading mode)

Barkan discloses a scanner having a dual optic system having two focusing lens 172a, 172b to provide a dual reading mode (i.e., a short range and long range reading mode) and a positioning trigger to selectively actuating the each reading mode. Therefore, the positioning trigger moves the dual optic system between the positions to selectively focus the light beam at the first foci and the second foci in the reading mode to selectively read the indicia located within one of the working distances or working ranges. Wherein the positions of focusing lens are located in and out of the optical path (see col. 14, lines 66+ and figure 16B).

In view of Barkan's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the dual mode scanning system in instrument of Huang as modified by Plesko in order to provide a different range of reading capability when reading coded indicia.

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Huang as modified by Plesko and Barkan fails to teach the specific switch that manually moving the component by the actuatable switch.

Kobayashi discloses a camera having a close-up lens 2 that may be selectively movable into and out of the optical path to selectively provide photographic condition. Wherein the close-up lens 2 is supported by the lens frame 2b. The lens frame having a switching means (selector portion 2a which projects outside the camera body A) for slidingly move the close-up lens 2 into and out of the optical path, i.e., the selector portion 2a mounted on the camera housing for movement by the user and operatively connected to the lens 2 for manually moving the lens by the selector 2a (see col. 2, lines 54+ and figures 11).

In view of Kobayashi's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the manual switching means in the instrument of Huang as modified by Plesko and Barkan in order to simplified the switching structure and to reduce the manufacturing costs of the instrument.

Re claim 19: Although Plesko teaches that the window at the front end 16A of the scanner where the light enters and exits is oriented generally perpendicular to a longitudinal axis of the reader, Huang as modified by Plesko, Barkan, and Kobayashi fails to show that the window in a plane that inclined at an angle to the axis of the reader.

It would have been obvious matter of design variation to incline the angle of the window relative to a longitudinal axis of the reader to further facilitate the reading device. Since the applicant has not disclosed that the window being inclined at an angle relative to an axis of the reader solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with perpendicular as well as inclined to a longitudinal axis of the reader. Furthermore, it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japike, 86 USPQ 70.

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Re claim 20: Although Huang shows the marking implement includes a fluid cartridge 12 having nip moved in and out of the metal barrel (see col. 1, lines 59-67), Huang as modified by Plesko, Barkan, and Kobayashi does not specifically teach a mechanism for retracting the nib within the housing and exposing the nip as the marker during marking.

However, the extending and retracting mechanism for a writing implement through an opening are old and well-known in the art. Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the notoriously old and well known and a conventional extending and retracting mechanism to the teachings of Huang as modified by Plesko, Barkan, and Kobayashi to protect the writing instrument from damaging when it is not in use and furthermore retracting the cartridge completely within the housing would extend the life of marking instrument.

7. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang as modified by Plesko, Barkan, and Kobayashi as applied to claims 1 and 12 above, and further in view of Wellner [US 5,640,193]. The teachings of Huang as modified by Plesko, Barkan, and Kobayashi have been discussed above.

Although Plesko teaches the reader having downloading and transmitting capability suited to package delivery industries and inventory application (i.e., the reader having a processor 35 for decoding the electrical signal into data represented by the coded indicia, a memory for storing the data within the housing, and downloading later or it may be transmitted by wireless means to a host terminal located remotely, see col. 16, lines 9-16; col. 18, lines 1-8); Huang as modified by Plesko, Barkan, and Kobayashi does not teach the memory contains user information relating such as a billing number and address for the user.

Wellner disclosed an electronic multimedia system for reading and processing transactions (see the abstract and figures 1-2), the system comprising a wand type hand-held optical reader 11 (i.e., a portable bar code symbol reader operable by a user) for reading an indicia 10 (i.e., a bar code) associated with products selected by the customer during marketing transactions (see col. 1, lines 36-39 and Figure 2). Wherein the indicia is a bar code that contains a Universal Resource Locator (URL) and accompanies a representation of a commercial product (see col. 1, lines 36-42, col. 4, lines 26-57, col. 7, lines 13-15) which is a file address corresponding to a network file containing an additional information relating to the product (see col. 2, lines 28-41). Wellner teaches a memory 404 within the reader to store the data and transmit the stored data at a later time via a user interface unit 15 that allows communication between the bar code reader and the host 18 (see Figures 1-2). Wellner further teaches the memory as a storage device for storing a user data relating to the user of the reader such as a scanner pen identification (ID) code which uniquely identifies the user by distinguishing the signals from different user's scanner pens that are in communication with the host (see col. 2, lines 66+). This scanner ID code is used by the host for the accounting or billing for services identified in the user's request command.

In view of Wellner's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the user identification data in the system of the Huang as modified by Plesko, Barkan, and Kobayashi in order to facilitate the transmitting record keeping process. Such modification would facilitate the transaction process such as a package delivery, inventory application, and etc.

8. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huang as modified by Plesko, Barkan, and Kobayashi as applied to claim 1 above, and further in view of Kubota et al. [US 5,956,021]. The teachings of Huang as modified by Plesko, Barkan, and Kobayashi have been discussed above.

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Although pen or hand held device is often utilized as a touch screen for a convince, Huang as modified by Plesko, Barkan, and Kobayashi is silent with respect to the writing instrument being a stylus for a touch screen of portable computer.

Kubota discloses an input device with a touch screen having a LCD panel 106 and tablet 108 and wherein the LCD panel displays representative keys to be selected by a stylus pen 109 (see the abstract and col. 1, lines 8-13, col. 2, lines 50+).

In view of Kubota's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to extend the use of the writing instrument of Huang as modified by Plesko, Barkan, and Kobayashi in order obtain a device that further utilize for inputting information on portable computer as well as on the paper.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 10-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 6,119,944 [referred as Patent'944] in view of Barkan et al. [US 6,098,877-referred as Barkan] and Kobayashi et al. [US 4,129,369]. The teachings of Barkan and Kobayashi have been discussed above.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application, for example, discloses a portable instrument for marking a surface in a marking mode of operation, and for selectively electro-optically reading coded indicia with different foci or different working distances relative to the instrument in a reading mode operation and wherein the portable instrument further comprises a housing configured to be held in a user hand; a light transmissive window on the housing; a plurality of electrical and optical components for directing a light beam through the window; one of the components being movable between a first and a second positions in which the light beam is focused at a first focus and at a second focus, respectively, during the reading mode relative to the window; and a manually actuatable switch mounted for moving said one of the component to selectively read the indicia located within one of the position.

Patent '944 discloses a portable, dual-use instrument for marking surfaces, and for electro optically collecting data for subsequent downloading having a marking implement at one end regions of the housing and a data collector in other regions of the housing wherein the data collector includes a light source directing a light beam to the symbol, a light sensor for detecting light reflected off the symbol and generating an electric signal indicative of the detected light, a processor for processing the electric signal, a memory for storing the processed signal for subsequent downloading, and a manually actuatable trigger for initiating scanning.

The difference between the inventions defined by the conflicting claims is the apparatus of the instant application utilizes a movable optical components having a two position (i.e., a first position for a first working distance of reading and a second position for a second working distance of reading), and an actuatable switch operatively connected to move the component between positions to selectively focus the light beam at the first and second foci in the reading mode.

The teachings of Barkan Kobayashi have been discussed above.

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In view of Barkan Kobayashi's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the movable optic lens to provide the dual mode scanning with the slidable actuator manually move the optic lens in the system of Patent'944 in order to provide a different range of reading capability with simplified trigger mounting configuration.

Response to Arguments

11. Applicant's arguments with respect to claim 10 have been considered but are moot in view of the new ground(s) of rejection (see the examiner's comment in the Additional Remarks above).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Dvorkis et al. [US 5,369,262] and Bearden et al. [US 4,748,318] discloses a wand type bar code reader; and

Taylor [GB 2,312,188], Rando et al. [US 5,874,722], and Epperson [US 5,247,137] discloses a hand held device having a dual capability, such as an optical reader and a marking implement.

13.

Suzuki et al. [US 3,836,934] and Toyoshima [US 4,063,260] discloses a movable lens which is "manually" moved "jointly with and directly by the switch.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is 703-306-3427. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this

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application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



D. I. Lee
Primary Examiner
Art Unit 2876

March 13, 2003